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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/502,542	02/10/2000	Bruce L Davis	60109	5321

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DIGIMARC CORPORATION  
9405 SW GEMINI DRIVE  
BEAVERTON, OR 97008

EXAMINER
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FADOK, MARK A

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/502,542

**Applicant(s)**

DAVIS ET AL.

**Examiner**

Mark Fadok

**Art Unit**

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                        |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/10/2000</u> . | 6) <input type="checkbox"/> Other: _____   |

### **DETAILED ACTION**

In view of the appeal brief filed on 8/11/2004, PROSECUTION IS HEREBY REOPENED. New grounds for rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(a) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or

(b) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

### **Examiner's Note**

Examiner has cited particular columns and line numbers or figures in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

### **Drawings**

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the additional features from the claims not depicted on the drawings must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 20-23 are rejected under 35 U.S.C. 102(e) as being anticipated by  
Treyz et al (6,587,835).**

In regards to claim 20, Treyz discloses a method of facilitating on-line shopping comprising: collecting data about products of interest during a shopper's visit to a bricks and mortar store, said data being collected prior to check-out; and using the data thereby acquired in a later on-line shopping session with said shopper (col 16, lines 37-55 and FIG 21).

In regards to claim 21, Treyz teaches wherein at least certain of the products of potential interest are not purchased by said shopper during said visit to said store (col 16, lines 37-55 and FIG 21).

In regards to claim 22, Treyz teaches wherein the data collection includes shopper activation of a shelf-based sensor associated with a product of interest (FIG 63).

In regards to claim 23, Treyz teaches wherein the data collection includes shopper use of a sensor device in the aisle of the store to collect data relating to a product of interest (see response to claim 20).

**Claims 1 and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Scroggie et al. (5,970,469).**

In regards to claim 1, Scroggie teaches a method comprising: presenting a collection of retail items, each having an indicia associated therewith, in a bricks and mortar store offering items for sale; sensing the indicia associated with selected ones of said items (FIG 13, Item 312);

compiling a list identifying the items whose indicia were sensed (FIG 14, block 406) maintains a database of customer purchase histories, and (col 12, lines 1-67); storing said list in a data structure associated with a user (col 12, lines 8-42); and later recalling said list (col 12, lines 24-42); using said recalled list to present a customized selection of items in an on-line shopping environment (FIG 14, col 12, lines 7-67 and col 13, lines 1-46).

receiving input from a user identifying a subset of items from said customized selection of items (col 2, lines 1-15).

In regards to claim 7, Scroggie discloses logging a shopper's habits or preferences exhibited in an on-line shopping environment in one or more database records associated with that shopper; and recalling said logged database record in a bricks and mortar store and using the logged information in connection with bricks and mortar shopping by said user (col 7, line 40- col 8, line 35).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 10,11 and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scoggie as in view of Treyz.**

In regards to claim 24,25 Scroggie teaches creating a running list of items for purchase (FIG 6), but does not specifically mention that sensing of at least one item occurs without an associated purchase transaction. Treyz teaches creating a list from anywhere with the handheld device used for inputting the information by scanning the

representative barcode or inputting the item by hand (FIG 21). It would have been obvious to a person having ordinary skill at the time of the invention to include in Scroggie the use of the Treyz scanner, because this a would provide an efficient means for gathering data to present a shopping list by providing an opportunity to change the list at a latter time.

In regards to claim 26, Scroggie teaches creating a running list of items for purchase, but does not specifically mention that the items are selected in a brick and mortar store. Treyz teaches creating a list from anywhere with the handheld device used for inputting the information by scanning the representative barcode or inputting the item by hand (FIG 21). It would have been obvious to a person having ordinary skill at the time of the invention to include in Scroggie the use of the Treyz, because this a would provide an efficient means for gathering data to present a shopping list.

In regards to claim 10 the combination of Scroggie and Treyz teaches which the sensing comprises sensing said selected items along aisles at which said items are displayed, away from a checkout stand (Treyz, col 47, line 55 - col 48, line 10).

In regards to claim 11 the combination of Scroggie and Treyz teaches sensing comprises sensing an RFID identifier (Treyz FIG 21).

**Claims 3-5,9,12-19 and 27 are rejected under 35 U.S.C. 103(a) as being**



**unpatentable over Kenny (6,381,583) in view of Treyz.**

In regards to claim 3, Kenny teaches identifying a user, but does not specifically mention that a login identifier is used to identify the user. Treyz teaches logging in to identify one's self, using an identifier (col 26, lines 15-34). It would be obvious to a person of ordinary skill in the art to include in Kenny a user login identifier, because this information would be needed to associate the user with previous purchase history stored in a database.

recalling a list of products associated with the user (col 6, lines 23-37)  
presenting products from said list to the user for selection (col 1, lines 47-52);  
receiving user selections of products to be purchased (col 1, lines 46-52);  
receiving an indication that the user is finished selecting products (FIG 10A); and  
thereafter querying the user regarding possible purchase of an item not selected by the user but on said recalled list, before completing the online shopping session (FIG 5 and FIG 7).

In regards to claim 4, the combination of Kenny and Treyz teaches computer storage medium having instructions thereon causing a computer to perform the process of claim 3 (see response to claim 3).

In regards to claim 5, the combination of Kenny and Treyz teaches which includes selecting said item in accordance with a procedure that depends, in part, on the passage of a predetermined interval of time without the user selecting said item for purchase (col 6, lines 24-37).

In regards to claim 12, Kenny teaches a recall list and providing the user with items not selected by the user, but does not specifically mention that the item is a cookie or dessert. The examiner maintains that the list would be considered the set of items and the items upon the list the sub-set, therefore, understanding the opportunity for an infinite number of products in a store being placed on this list, the examiner has concluded that all items that could be present on a list are included as the sub-set to the total set of items being the list. Furthermore, the examiner does not understand the applicant's apparent differentiation between a dessert and a cookie, considering that one of ordinary skill in the art might consider a cookie (sub-set) within the definition of a dessert item (total set or list), an example being a fortune cookie presented at the end of a Chinese meal as a dessert. Webster's dictionary defines dessert as a sweet course or dish served at the end of a meal. Considering this definition the examiner also points the applicant's attention to FIG 6, which has presented several sweet items such as hot cocoa and granola.

In regards to claim 13, Kenny teaches in which the item is the subject of said query only if said the user has not purchased item for a predetermined period (col 9, lines 14-33).

In regards to claim 14, Kenny teaches in which the item is the subject of said query only if the user has demonstrated a prior purchasing habit related to said item, and the omission of said item is not in accordance with said demonstrated habit (col 1, lines 25-30).

In regards to claim 9, Kenny teaches displaying a virtual shopping aisle with graphical - rather than strictly textual - representations of items for sale (FIG 4), wherein items of potential interest to a shopper are presented more prominently than other items (FIG 7), and Kenny teaches creating a running list of items for purchase, but does not specifically mention that the items are selected in a brick and mortar store. Treyz teaches creating a list from anywhere with the handheld device used for inputting the information by scanning the representative barcode of inputting the item by hand (FIG 21). It would have been obvious to a person having ordinary skill at the time of the invention to include in Kenny the use of the Treyz, because this a would provide an efficient means for gathering data to present a shopping list.

In regards to claim 15 the combination of Kenny and Treyz teaches wherein said

activity is activity in a bricks and mortar store associated with the first vendor (Treyz, FIG 72).

In regards to claim 16 the combination of Kenny and Treyz teaches wherein said activity is a shopping activity (Treyz, FIG 21).

In regards to claim 17, Kenny teaches displaying a virtual shopping aisle with graphical - rather than strictly textual -representations of items for sale (FIG 4), wherein items of potential interest to a shopper are presented more prominently than other items (FIG 7), and Kenny teaches creating a running list of items for purchase, but does not specifically mention that the items are selected in a brick and mortar store. Treyz teaches creating a list from anywhere with the handheld device used for inputting the information by scanning the representative barcode of inputting the item by hand (FIG 21). It would have been obvious to a person having ordinary skill at the time of the invention to include in Kenny the use of the Treyz, because this a would provide an efficient means for gathering data to present a shopping list. wherein said items of potential interest include at least one item that the shopper has not previously purchased from said first vendor (Treyz, FIG 72).

In regards to claim 18, the combination of Kenny and Treyz discloses a method of on-line shopping from a first vendor, an improvement comprising displaying a virtual shopping aisle with graphical - rather than strictly textual -representations of items for

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sale, wherein items of potential interest to a shopper are presented more prominently than other items, and that includes identifying items of potential interest by reference to the shopper's prior shopping history, where said history includes transactions with vendors other than said first vendor (see response to claim 17)

In regards to claim 19, the combination of Kenny and Treyz discloses a method of on-line shopping from a first vendor, an improvement comprising displaying a virtual shopping aisle with graphical - rather than strictly textual -representations of items for sale, wherein items of potential interest to a shopper are presented more prominently than other items, and that includes identifying items or potential interest (see response to claim 17), Treyz teaches creating a list from anywhere with the handheld device used for inputting the information by scanning the representative barcode of inputting the item by hand (FIG 21). It would have been obvious to a person having ordinary skill at the time of the invention to include in Kenny the use of the Treyz to scan information from home, because this a would provide an efficient means for gathering data to present a shopping list and save the person time from having to go to the store to scan a product with a system that has the capability to scan the product anywhere including from the user's own home.

In regards to claim 27, Kenny teaches creating a running list of items for purchase, but does not specifically mention that the items are selected in a brick and

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mortar store. Treyz teaches creating a list from anywhere with the handheld device used for inputting the information by scanning the representative barcode or inputting the item by hand (FIG 21). It would have been obvious to a person having ordinary skill at the time of the invention to include in Kenny the use of the Treyz, because this a would provide an efficient means for gathering data to present a shopping list.

Claims 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kenny (6,381,583) in view of Treyz and further in view of Official Notice.

In regards to claim 6, the combination of Kenny and Treyz teaches programming means for displaying various lists of previously ordered products (col 6, lines 4-67) with information provided in the lists including price (col 4, lines 4-65). Kenny/Treyz, however does not specifically mention presenting an additional item for sale if a price total price of items meets a pre-determined criteria. It was old and well known in the art at the time of the invention to provide additional items for sale when a specified total spending has been not been achieved such as a budget or gift allocation. It would have been obvious to a person having ordinary skill in the art to include in the invention of Kenny/Treyz using spending criteria to present additional products and promotions, because it is notoriously well known that people will be more responsive to an offer when they can afford it than when they can't.

### **Response to Arguments**

Applicant's arguments with respect to claims 1-27 have been considered but are

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moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **(703) 605-4252**. The examiner can normally be reached Monday thru Thursday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wynn Coggins** can be reached on **(703) 308-1344**.

**Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.**

Any response to this action should be mailed to:

***Commissioner for Patents***

***P.O. Box 1450***

**Alexandria, Va. 22313-1450**

or faxed to:

**(703) 872-9306**

[Official communications; including

After Final communications labeled

"Box AF"]

**(703) 746-7206** [Informal/Draft communications, labeled


"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal  
Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.



Mark Fadok

Patent examiner

  
WYNN W. COGGINS  
SUPERVISORY PATENT EXAMINER  
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